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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/776,190

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Tetsuya Tsujikawa

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EXAMINER

HO, HOAI V

ART UNIT

PAPER NUMBER

2818

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/776,190	Applicant(s) TSUJIKAWA ET AL.	
	Examiner Hoai V. Ho	Art Unit 2818	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/250,157.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/12/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. This office acknowledges receipt of the following items from the Applicant:

Information Disclosure Statement (IDS) was considered.

Applicant claimed for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No 09/250,157.

2. Claims 5-12 are presented for examination.

Claims 1-4 are canceled.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1-12 (excluding the rejected limitations in claim 1 under 35 U.S.C. 112, first paragraph below) are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,507,502. Although the conflicting claims are not identical, they are not patentably distinct from each other because that the claimed invention of the instant application recites nonvolatile memory device, a control circuit, a plurality of commands comprising a first “type format” command and a second “type format” command which are the same scope as the patent ‘502. For example, the patent ‘502 discloses a nonvolatile memory device, a control device, a plurality of commands comprising a first command and a second command, the first command writes data to memory cells, the second command reads data from the memory cells and writes data to the memory cell.

The claim seems to differ from the patent ‘502 in that the claimed invention of the instant application recites a “plurality of input/output terminals” while in ‘502, however, claimed a “nonvolatile memory system” and “... write data from outside of the memory device.” Therefore, one of ordinary skill in the art would have recognized that the plurality of input/output terminals must be in the nonvolatile memory system in order to command the memory operations.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 1, lines 14 and 15 “wherein said second type command indicates a termination of said second type format command,” “wherein said first type format command includes a first type command without a second type command,” “wherein said second type format command includes said first type command and said second type command,” “wherein said first type format command includes a first read command, a first write command and an erase command, and wherein said second type format command includes a second write command” are not described in the specification.

7. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7, lines 4 and 5, “wherein said second type format command includes a second write command” is unclear and confusing. How does it relate to “wherein said second type command indicates a termination of said second type format command” in lines 14 and 15 of claim 5?

Claim 6 is rejected for incorporating the defects of the parent claim.

Claims 8-12 are rejected due to the rejections of the parent claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 5-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Hamakawa U. S. Patent No. 5,881,002.

As per claims 5-7, Figure 1 of Hamakawa is directed to a nonvolatile memory comprising a plurality of input/output terminals (/WE, /CE/, /OE); and a control circuit (37, 45, 47), wherein said control circuit is capable of receiving an arbitrary one of a plurality of commands (col. 6, lines 34 and 35) via said plurality of input/output terminals, wherein said plurality of commands comprise a first type format command (e.g., reading) and a second type format command (e.g. writing); wherein said first type format command includes a first type command without a second type command (claim 16, col. 6, lines 34 and 35), wherein said second type format command includes said first type command and said second type command (col. 12, line 15).

As per claim 8, Figure 1 of Hamakawa discloses further comprising a nonvolatile memory array (1) and a latch circuit (7).

As per claim 9, Figure 1 of Hamakawa discloses wherein said control circuit controls outputting data read out from said nonvolatile memory array according to said address information when receiving said first read command (col. 9, lines 13-36).

As per claim 10, Figure 1 of Hamakawa discloses wherein said control circuit controls writing data stored in said latch circuit to said nonvolatile memory array according to said address information when receiving said first write command (col. 8, lines 53-65).

As per claim 11, Figure 1 of Hamakawa discloses wherein said control circuit controls erasing data stored in said nonvolatile memory array according to said address information when receiving said erase command (col. 7, lines 41-56).

As per claim 12, Figure 1 of Hamakawa discloses wherein said control circuit controls writing data received from outside to said nonvolatile memory array according to said address information when receiving said second write command (col. 12, line 15).

10. When responding to the office action, Applicants are advised to provide the examiner with the line numbers and page numbers in the application and/or references cited to assist the examiner to locate the appropriate paragraphs.

11. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) day from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02 (b)).

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to whose telephone number is (571) 272-1777. Other inquiries of this application should be called to (571) 272-1562 or the fax number (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



H. Ho
May 19, 2004



Hoai V. Ho
Primary Examiner
Art Unit 2818